

REMARKS

This Amendment is intended to respond fully to the first Office Action dated August 18, 2003 in which claims 1-2, 4-7, 20, 22-23, 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,473,069 ("Gerpheide") in view of U.S. Patent No. 5,627,567 ("Davidson"); claims 3, 8-9, 11-17, 21 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gerpheide and Davidson in view of U.S. Patent No. 6,031,525 ("Perlin"); claims 10 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Gerpheide, Davidson, Perlin and U.S. Patent No. 6,441,753 ("Montgomery"); and claims 16, 18-19, 27-35 were objected to as being dependent upon a rejected base claim. The Examiner kindly indicated that claims 16, 18-19, 27-35 would be in allowable form if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also in this first Office Action, the Specification was objected to as having an improperly phrased Abstract and containing an informality. Further, the Drawings were objected to as failing to show an item described in the Specification.

In this Amendment, the Abstract, Specification and Drawings have been amended. Claim 27 has been rewritten in independent form and claim 28 has been amended to consistently depend from rewritten claim 27. Claims 1-35 remain pending and are believed allowable for at least the reasons set forth below. As such, Applicant respectfully requests reconsideration of the aforementioned objections and rejections in view of these amendments and the following remarks.

A. Drawings Amendment

FIG. 5 is hereby amended to include a reference numeral "504" and associated lead line in response to the Examiner's objection under 37 C.F.R. §1.83(a).

B. Specification Amendments

1. The Abstract is hereby amended in response to the Examiner's objection and is believed to be in the proper language and format.

2. The improper reference to "FIG. 5B" found on page 11 in the specification is hereby removed in response to the Examiner's objection.

C. Claim Rejections

In the Office Action, independent claims 1 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gerpheide in view of Davidson and independent claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Gerpheide, Davidson and Perlin. All other claims pending in this application depend from these independent claims and are rejected as being obvious under 35 U.S.C. §103(a) based on a combination of various other references with the references used to reject the underlying independent claim for each dependent claim. As articulated in greater detail below, these rejections are respectfully traversed.

1. Claims 1-12 and 20-26:

In general, claim 1 recites a user input device for inputting commands into a computer system and claim 20 recites a method of using this user input device. The input device has a tactile surface that is divided into a plurality of sections. Each section is tactilely distinguished from its adjacent sections. Further, at least one input sensing device is dispersed on each section. The input sensing devices detect input strokes defining user requests being input into a computing system. In response to detection of an input stroke, an input sensing device transmits a selection signal indicative of the user request to the computing system.

As stated in the Office Action, neither Gerpheide nor Davidson recite each limitation of claims 1 and 20, and therefore neither reference anticipates claim 1 or claim 20. As such, the examiner relies on a combination of these references to reject claims 1 and 20 under 35 U.S.C. §103(a). However, as articulated in more detail below, this rejection to claim 1 is improper because the Office Action fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a). *See MPEP, at §706.02(j).*

Turning to the references, Gerpheide is directed to a tactile surface for use on an input device for a computer system, while Davidson is directed to a touch screen display having graphically displayed controls that, when touched by a user, render performance of a function associated with the controls. In rejecting claims 1 and 20, the Office Action states that it “would have been obvious” to combine the touch pad of Gerpheide with the function selection approach of Davidson, but otherwise provides no such proof. See Office Action, page 3. For the reasons noted in the following paragraphs, such a conclusory statement is not sufficient to establish a prima facie case of obviousness.

Identification in a combination of prior art references of the individual limitations claimed is insufficient to defeat patentability of the claimed invention as a whole. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching to support an obviousness-based rejection may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

Applying the foregoing rules of law to the instant rejections, neither reference includes, implicitly or explicitly, a motivation, suggestion or teaching that would result in the combination of the touch-pad of Gerpheide with the display of Davidson. The only user interface taught by Davidson is a touch screen interface being displayed through a standard touch screen display panel 10 (FIG. 1). The only user interface taught by Gerpheide is the touch-pad 32 (FIG. 3), which is a wholly separate device than the display 20 (also FIG. 3). Nowhere in Davidson is there a disclosure or suggestion to modify the touch screen to have different sections being tactilely distinguished from adjacent sections. Indeed, the touch screen, like all conventional touch screens, is associated with a uniform planar surface. Additionally, nowhere in Gerpheide is the surface of the touch-pad 32 described as being alternatively used on the display 20.

The Office Action further does not provide evidence that knowledge of one skilled in the art would provide the motivation, suggestion or teaching to combine these references. And the Office Action does not provide any evidence that the teaching, suggestion or motivation is implicit in the prior art. Indeed, such a motivation would not have been provided by one of skill in the art at the time of the Applicant's invention because Davidson actually teaches away from the use of a separate input device in conjunction with the touch screen interface by focusing solely on methods for improving user interaction with the *touch* screen. Thus, a motivation to

combine these references to render the invention recited in claims 1 and 20 is definitely not implicit from the prior art as a whole.

When the prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroyal Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In the present application, no such reason has been provided to explain the selection and combination of certain teachings from each applied reference. The only conclusion that can be reached from the alleged combinability of the references is the impermissible hindsight gleaned from the present invention. See, e.g., Ex parte Haymond, 41 USPQ2d 1217, 1220 (BdPatApp&Int 1996) (the examiner "may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.).

Accordingly, a *prima facie* case of obviousness has not been made against claims 1 and 20. These claims are therefore believed allowable over the art of record. Claims 2-12 depend from claim 1, and hence, recite an invention that incorporates the same limitations of claim 1. Additionally, claims 21-26 depend from claim 20, and hence, recite an invention that incorporates the same limitations of claim 20. Thus, without addressing claims 2-12 and 21-26 in detail, each of these claims are believed allowable over the art of record for at least the reasons noted above in connection with claims 1 and 20, respectively.

2. Claims 13-19:

In general, claim 13 recites the user input device of claim 1, wherein each of the plurality of sections are embodied in petals angularly dividing the tactile surface (touchpad). Further, the device of claim 13 includes a central portion separating the center of the tactile touchpad from the plurality of petals and an outer portion separating the outer boundary of the tactile touchpad from the plurality of petals. The central and outer portions are tactilely distinguished from the plurality of petals thereby each forming a single section. Thus, like the petals, the central and outer portion each have at least one input sensing device.

The same conclusory statement provided in the Office Action to reject claims 1 and 20 under 35 U.S.C. §103 was used in the Office Action to reject claim 13. See Page 8, paragraph 3. As noted above, such a statement, without any factual basis establishing such a motivation, is not sufficient to establish a *prima facie* case of obviousness. Furthermore, because neither of

these references provide a motivation, suggestion or teaching to combine the tactile features of Gerpheide with the touchscreen of Davidson, such a motivation is an improper combination gleaned only from the use of improper hindsight. Thus, for the reasons stated above in traversing the rejection to claims 1 and 20, claim 13 is believed allowable over the art of record.

Moreover, the Office Action states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the central portion and petals as shown by Perlin in the Gerpheide and Davidson apparatus...reference)." *See page 9, paragraph 1.* Here, the Office Action is using the improper Gerpheide-Davidson combination to support a finding of the central portion recited in this claim in the prior art. Again, no motivation or suggestion to make this combination other than a conclusory, unsupported statement is provided in the Office Action, and thus this modification as a whole was founded on the basis of double-hindsight - one resulting in the Gerpheide-Davidson combination and the other resulting in the Gerpheide-Davidson-Perlin combination.

In light of the foregoing, a *prima facie* case of obviousness has not been made against claim 13. Claim 13 is therefore believed allowable over the art of record. Claims 14-19 depend from claim 13, and hence, recite an invention that incorporates the same limitations of claim 13. Thus, without addressing claims 14-19 in detail, each of these claims are believed allowable over the art of record for at least the reasons noted above in connection with claim 13. Further, claims 16 and 18-19 have been indicated as reciting allowable subject matter, though objected to for depending from a rejected base claim. *See Office Action, pages 10-11.* Therefore, these claims are believed further allowable for at least the reasons provided on pages 10-11 of the Office Action.

D. Claim Objections

Claims 27-35 recite allowable subject matter and are only rejected because these claims depend from a rejected base claim. *See Office Action, pages 10-11.* In fact, the Office Action indicates that these claims would be allowable if rewritten to include the limitations of all base and intervening claims. As such, claim 27 has been rewritten in independent form to include the limitations of claim 20, the base independent claim that claim 27 depended from. It is duly noted that claim 27 has not been amended for reasons related to patentability, but rather this claim recites the exact same limitations of claim 27 as originally filed. Indeed, claim 27 has been

rewritten as a formal matter in order to structure the claim in independent form. Claims 28-35 each depend from claim 27 and therefore, because claim 27 has been rewritten to include the limitations of its previously base independent claim, claims 28-35 are now in allowable form.

The Applicant kindly thanks the Examiner for indicating the allowability of claims 27-35 and for providing a statement of reasons for allowance. Applicant would like to note that the reasons for allowance of claims 27-35 provided by the Examiner are not the only reasons that these claims are allowable over the art of record. Indeed, other reasons for allowability exist.

CONCLUSION

This Amendment and the accompanying remarks is believed to be responsive to all points raised in the Office Action mailed August 18, 2003. Still, the Office Action may contain other arguments that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicants believe the argument to have merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, that are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

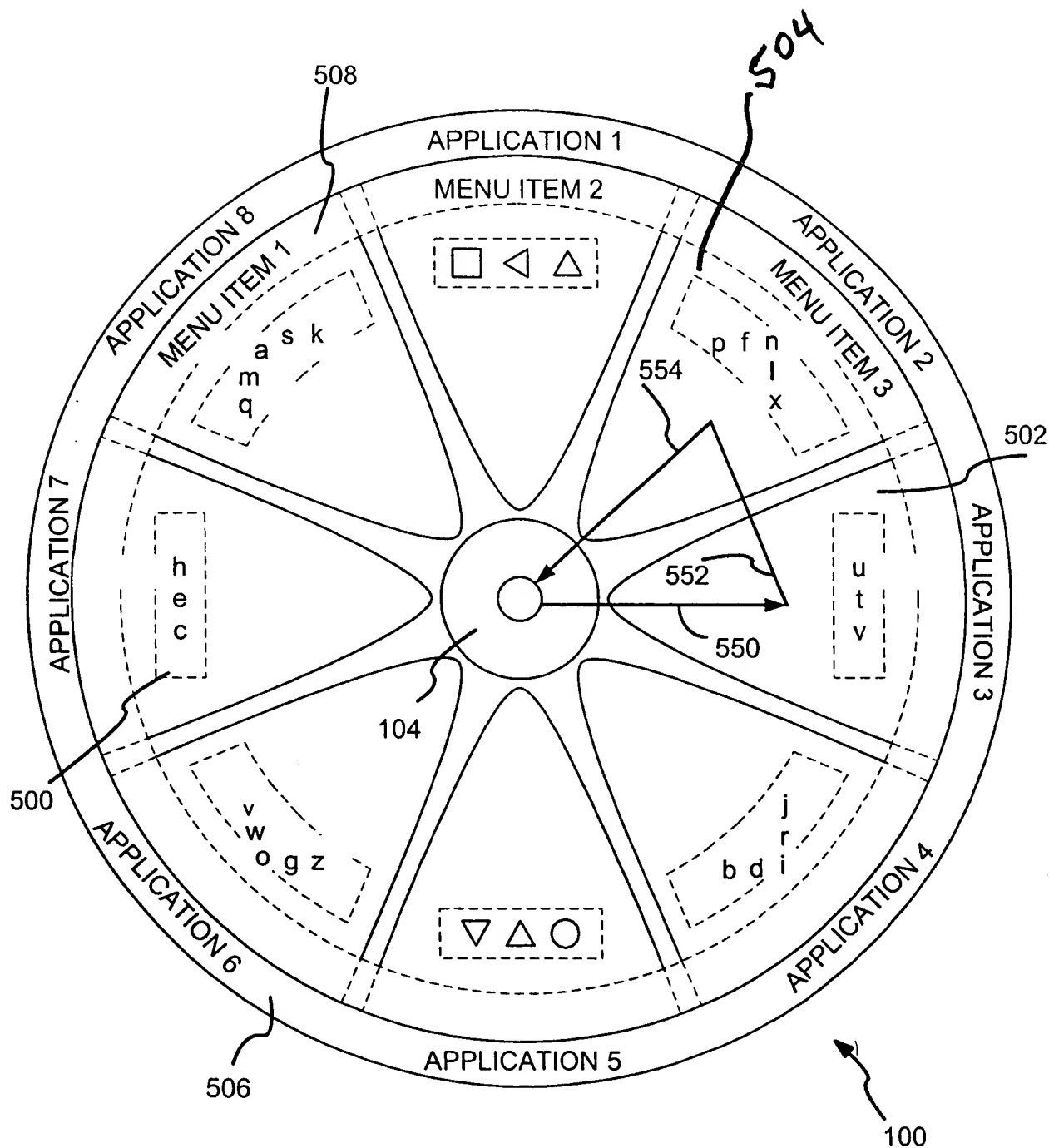
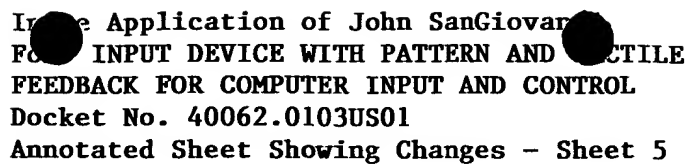
Claims 1-35 are pending in the application and are believed to clearly be allowable over the art of record. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns. A check covering the addition of one independent claim is submitted with this Amendment. Please charge any additional fee to Deposit Account No. 13-2725. Also, please credit any overpayment to Deposit Account No. 13-2725.

Respectfully submitted,



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Approved by
examiner.
L.S. 01.08.04

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